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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,089	12/13/2001	Steffen Denzinger	WI 00004	6890

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EXAMINER	
CHU, JOHN S Y	

ART UNIT	PAPER NUMBER
1752	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

5M

Office Action Summary	Application No.	Applicant(s)	
	10/016,089	DENZINGER ET AL.	
	Examiner	Art Unit	
	John S. Chu	1752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 January 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *18-35* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *18-20,25,27-29 and 33* is/are rejected.

7)☒ Claim(s) *21-24,26,30-32,34 and 35* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the application filed January 12, 2004.

1. The rejection under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over GB 2,324,381 (ALLEN et al) is **withdrawn** in view of arguments by applicant wherein there is no explicit teaching for the Bekk smoothness to be in the claimed range of 5 to 800 sec. The back layer of ALLEN et al (act. GATES et al) is not disclose upon coating is not disclosed to be modified to give an alternative surface except on that would be expected to be smooth.

2. Likewise the rejection under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DENZINGER et al is also **withdrawn** wherein there is no explicit teaching in the reference to show that the Bekk smoothness property is present in the back layer of DENZINGER et al '298. Applicants refer to the comparative examples in DENZINGER et al wherein 20 stacked printing plates having a 5 kg weight placed on them for 48 hours. Upon separation the Table indicates "considerable adhesion" when a silica gel filler particle is lacking in the photosensitive layer, which is placed in contact with the back layer of those same plates. Thus the results imply that the back layers show a surface which is smooth and not rough because upon separation there was damage to layers.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 18-20, 25,27-29 and 33 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over KATOH et al '037.

The claimed invention is drawn to a recording material for the production of offset printing plates, which comprises a web- plate-form support, a radiation-sensitive layer on the front of the support and a continuous, pigment particle-free layer on the back , and the back layer consists essentially of an organic polymeric material having a glass transition temperature Tg of at least 45° C, and said material has a surface and said surface has a Bekk smoothness of from 5 to 800 s. The claims are further drawn to a process for the production of the recording material according, which comprises applying the back layer, by roller application.

KATOH et al discloses a lithographic printing plate precursor having a back coat, comprising a polyvinyl alcohol-polyethylene copolymer with no pigment particles, see Example 4 in column 51 and 52. The copolymer is asserted inherently to meet the claimed Tg as recited and the back layer meets the lack of pigment particle limitation as claimed. The Bekk smoothness is also inherently disclosed to be met by the back layer of Example 4 based on the preferred teaching in KATOH et al found in column 7, line 44 – column 8, line 17. The preferred Bekk smoothness of the back layer is recited to be 10 to 250 seconds, preferably 50 to 180 seconds which is in the claimed range as recited in claim 18.

Alternatively, if it is shown that the copolymer binder of Example 4 falls outside of the Tg range as claimed, it is asserted that it would have been *prima facie* obvious to the skilled artisan in printing plates to use any of the disclosed polymer binders, such as polyvinyl alcohol,

disclosed for use in the photosensitive layer or a non-photosensitive layer in the back layer as motivated by KATOH et al in column 7, line 45 – 58 with the reasonable expectation of same or similar results for a photothermographic material having satisfactory photographic properties, such as suppression of fog in humidity.

5. Claims 21-24,26,30-32,34 and 35 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

None of the prior art references disclose the claimed limitations in the dependent claims as listed above.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DENZINGER et al '092 and '097 disclose offset printing plates wherein a back-coated layer is provided on the substrate. DENZINGER et al '092 and '097 meet the claimed glass transition temperature of the polymers used in the backing layer, however lack the disclosure for a pigment particle-less backing layer having a Bekk smoothness as claimed.

KATOH et al '244 is the daughter patent to '037 above.

Chenier, Phillip, J "Survey of Industrial Chemistry (3rd edition), Kluwer Academic Publishers/Plenum Press, Copyright 2002, pp 265-287, discloses Tg of conventional polymers.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Chu whose telephone number is (703) 308-2298. The examiner can normally be reached on Monday - Friday from 9:30 am to 6:00 pm.

The fax phone number for this Group is (703) 305-7718.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

John S. Chu
Primary Examiner, Group 1700

J.Chu
March 12, 2004